

ESTTA Tracking number: **ESTTA685198**

Filing date: **07/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	University of Southern California
Granted to Date of previous extension	07/22/2015
Address	University Park CampusADM 352 - Mail Cod Los Angeles, CA 90089-5013 UNITED STATES
Attorney information	Michael Adler Tantalo & Adler LLP 1901 Avenue of the Stars, Suite 1000 Los Angeles, CA 90067 UNITED STATES madler@ta-llp.com Phone:310-734-8694

Applicant Information

Application No	79150583	Publication date	03/24/2015
Opposition Filing Date	07/22/2015	Opposition Period Ends	07/22/2015
International Registration No.	1212652	International Registration Date	06/14/2014
Applicant	Heckler & Koch GmbH Heckler & Koch-Str. 1 GERMANY		

Goods/Services Affected by Opposition


Class 008. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cutlery, side arms, namely, swords, bayonets, hunting knives, fishing knives and pocket knives
Class 013. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Firearms; ammunition and projectiles; explosives; fireworks; air pistol weapons; air gun weapons; stun guns; soft-air-weapons, namely, air rifles, air pistols
Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Toy weapons; toy air pistols; toy air guns; toy pistols; toy paintball guns

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Dilution	Trademark Act section 43(c)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2319979	Application Date	06/10/1996
Registration Date	02/22/2000	Foreign Priority Date	NONE
Word Mark	USC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1910/00/00 First Use In Commerce: 1910/00/00 educational services, namely, providing classes, courses and seminars at the undergraduate, graduate, post-graduate, adult education and professional levels; and entertainment services, namely, conducting athletic and cultural events, and musical, dance, theatrical and dramatic performances		


U.S. Registration No.	1689594	Application Date	09/05/1990
Registration Date	05/26/1992	Foreign Priority Date	NONE
Word Mark	USC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1880/00/00 First Use In Commerce: 1920/00/00 sweatshirts and T-shirts, all goods being offered and sold to persons through university authorized channels of trade		

U.S. Registration No.	1240848	Application Date	07/03/1978
Registration Date	06/07/1983	Foreign Priority Date	NONE
Word Mark	USC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Car Emblems of Non-Precious Metal, Key Rings of Non-Precious Metal, License Plate Frames[, Art Work Statuary of Non-Precious Metal] Class 010. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00		

	<p>[Baby Bottles]</p> <p>Class 011. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Electrically Operated Lamps[, Toilet Seats]</p> <p>Class 012. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 [Car Horns and Bike Bags]</p> <p>Class 014. First use: First Use: 1914/00/00 First Use In Commerce: 1914/00/00 Charms, Necklaces, Bracelets, Gold Earrings, Clocks, Watches, Rings, Tie Tacs</p> <p>Class 016. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Playing Cards and Decals</p> <p>Class 018. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Umbrellas, and Luggage-Namely, Tote Bags, Hand Luggage, Garment Bags and Overnight Bags</p> <p>Class 020. First use: First Use: 1974/09/00 First Use In Commerce: 1974/09/00 Pillows</p> <p>Class 021. First use: First Use: 1920/00/00 First Use In Commerce: 1920/00/00 Pewter Mugs, Mugs, Temperature Retaining Vessels, Glassware</p> <p>Class 024. First use: First Use: 1933/00/00 First Use In Commerce: 1933/00/00 Towels, Blankets, Pennants</p> <p>Class 025. First use: First Use: 1914/00/00 First Use In Commerce: 1914/00/00 Adult and Children's Jackets, Men's Shirts, Sportshirts, Ties, Bibs, Baby Pants, Sleepshirts, Robes, [Tennis Skirts,]Ladies' Tops, Adult and Children's Jerseys, Caps, Sport Caps, Crew Caps, Visor Caps, Ski Caps, Deck Shoes, Tennis Shoes, Sweaters, Adult and Children's Mittens,[Golf Sweaters,] Ladies', Men's and Children's T-Shirts, Baseball Shirts, Football-Style Jerseys, Ladies' and Men's Shorts, Socks, Adult and Children's Warm-Up Suits</p> <p>Class 026. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 Buttons, Decorative Patches, Pins and Broaches of Non-Precious Metal</p> <p>Class 028. First use: First Use: 1975/09/00 First Use In Commerce: 1975/09/00 [Racquet Covers,]Football, Toy Stuffed Animals</p>
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U.S. Registration No.	4542209	Application Date	06/18/2013
Registration Date	06/03/2014	Foreign Priority Date	NONE
Word Mark	USC TELEHEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2011/10/01 First Use In Commerce: 2011/10/01 Clinical mental health counseling services; Telemedicine services		

U.S. Registration No.	2711042	Application Date	04/04/2002
Registration Date	04/29/2003	Foreign Priority Date	NONE
Word Mark	USC ALUMNI ASSOCIATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 Association services, namely, promoting the interests of the alumni of the University of Southern California Class 200. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 Indicating membership in an association of alumni of the University of Southern California		

U.S. Registration No.	2718936	Application Date	05/09/2002
Registration Date	05/27/2003	Foreign Priority Date	NONE
Word Mark	USC TROJAN FAMILY MAGAZINE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1992/09/00 First Use In Commerce: 1992/09/00 General feature magazine		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	USC		
Goods/Services	Opposer is the owner of common law rights in the name USC and various related marks arising from Opposer's educational and athletic programs beginning as early as 1880. Opposer has directly used and additionally licensed USC and related marks in a wide range of goods and services arising from such educational and athletic programs, including but not limited to publications, merchandise sold in stores and catalogs, merchandise sold through third-party stores, musical, dramatic and artistic performances, etc.		

Attachments	75116291#TMSN.png(bytes) 85963134#TMSN.png(bytes) 76391618#TMSN.png(bytes) 76406799#TMSN.png(bytes) 2015-07-22 Grounds for Opposition Heckler and Koch USC.pdf(139918 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Signature	/Michael S. Adler/
Name	Michael Adler
Date	07/22/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

CAROLINA COLLEGIATE FEDERAL
CREDIT UNION

Applicant.

Opposition No.

Serial No. 79/150,583

Mark: **USC**

Filed: August 15, 2014

Published: March 24, 2015

NOTICE OF OPPOSITION

Opposer, the University of Southern California, a California non-profit corporation located at University Park, ADM 352, Los Angeles, California hereby files this Notice of Opposition against the captioned application (the “USC Application”), alleging as follows:

1. Based on Opposer’s previous request to extend the time in which to oppose the USC Application, the deadline to file a Notice of Opposition is July 22, 2015.

2. On knowledge and belief, the USC Application is owned by Hekler & Koch GmbH, a GmbH organized under the laws of the country of Germany having a principal address of Hekler & Koch-Str. 1, 78727 Oberndorf, Germany.

3. According to the current records of the United States Patent and Trademark Office, the USC Application is an application for registration a mark in typed form with the wording of “USC” in International Class 008, 013, and 028 for (i) Cutlery, side arms, namely,

swords, bayonets, hunting knives, fishing knives and pocket knives, (ii) Firearms; ammunition and projectiles; explosives; fireworks; air pistol weapons; air gun weapons; stun guns; soft-air- weapons, namely, air rifles, air pistols and (iii) Toy weapons; toy air pistols; toy air guns; toy pistols; toy paintball guns, respectively.

4. Opposer is the oldest private research university in the Western United States, with a national and international reputation. Opposer has not only provided a wide variety of collegiate goods and services on its own account, but Opposer has also licensed various goods and services under the name USC and various related marks for decades. Opposer and its authorized licensees have used the USC mark and various related marks including USC in commerce continuously since at least 1880. Opposer's USC mark is a highly distinctive collegiate mark and through extensive advertising and use, the USC mark has become strongly associated with Opposer's goods and services. In particular, without limitation:

5. Opposer is the owner of Federal Registration 2,319,979 for the mark "USC" for educational services in International Class 41 in the area comprising the states of Washington, Oregon, California, Nevada, Idaho, Arizona, Utah, Colorado, Wyoming, Montana, New Mexico, Texas, North Dakota, South Dakota, Nebraska, Kansas, Oklahoma, Minnesota, Iowa, Missouri, Massachusetts, Illinois, and Hawaii. Registration No. 2,319,979 is valid, subsisting, and incontestable. Opposer has used the USC mark and various related marks in connection with educational services continuously since at least 1996.

6. Opposer is also the owner of Federal Registration 1,689,594 for the mark "USC" in International Class 25 for sweatshirts and T-shirts, all goods being offered and sold to persons through university authorized channels of trade. Registration No. 1,689,594 is valid, subsisting,

and incontestable. Opposer has used the USC mark and various related marks in connection with clothing continuously since at least 1990.

7. Opposer is also the owner of Federal Registration 1,240,848 for the mark “USC” for various goods in International Classes 006, 011, 014, 016, 018, 020, 021, 024, 025, 028, and 028. Registration No. 1,240,848 is valid, subsisting, and incontestable. Opposer has used the USC mark and various related marks in connection with the goods identified in that registration continuously since at least 1978.

8. Opposer is also the owner of Federal Registration 4,542,209 for the mark “USC Telehealth” for services and related matters in International Class 44. Registration No. 4,542,209 is valid, subsisting, and incontestable. Opposer has used the USC Telehealth mark and various related marks in connection with the services identified in that registration continuously since at least 2011.

9. Opposer is also the owner of Federal Registration 2,711,042 for the mark “USC Alumni Association” for services and related matters in International Classes 35 and 200. Registration No. 2,711,042 is valid, subsisting, and incontestable. Opposer has used the USC Alumni Association mark and various related marks in connection with the services identified in that registration continuously since at least 1990.

10. Opposer is also the owner of Federal Registration 2,718,936 for the mark “USC Trojan Family Magazine” for publications in International Classes 16. Registration No. 2,718,936 is valid, subsisting, and incontestable. Opposer has used the USC Trojan Family Magazine mark and various related marks in connection with the services identified in that registration continuously since at least 1993.

11. Goods and Services: Opposer is also the owner of extensive common law rights in the name USC and various related marks arising from Opposer's educational and athletic programs beginning as early as 1880. Opposer has directly used and additionally licensed USC and related marks in a wide range of goods and services arising from such educational and athletic programs, including but not limited to publications, merchandise sold its in stores and catalogs, merchandise sold through third-party stores, musical, dramatic and artistic performances, etc.

12. As a result of extensive advertisement, promotion, and sale of goods and services using the USC mark, the mark has gained widespread and favorable public acceptance and recognition. The University of Southern California's USC mark (and related marks) are associated with and identify Opposer.

13. Opposer has developed valuable good will with respect to the USC mark.

14. The USC mark is a famous and distinctive mark, and represents an asset of incalculable value as a symbol of Opposer, the University of Southern California, its quality goods and services, and its goodwill.

15. Opposer believes that it will be damaged by the registration of the Applicant's proposed mark both because an appreciable number of members of the consuming public may improperly assume that applicant's services are associated with, endorsed by, or affiliated with Opposer and further because registration of the Applicant's proposed mark would lead to tarnishment and/or dilution of Opposer's established registration and common law rights in USC and various related marks. Opposer therefore has a real interest and a direct stake in the outcome of the proceeding and Opposer opposes the registration in whole.

16. Opposer's trademark rights in the USC mark are valid, subsisting and have not been abandoned. Opposer further alleges that its right have priority over any rights of Applicant.

17. Opposer's USC mark and its related marks are similar or identical to Applicant's mark in sight and sound.

18. The Applicant's application includes goods which are already the subject of Opposer's licensed activities (*e.g.* USC™ pocket-knives and a wide variety of toys).

19. If Applicant were granted the registration herein opposed, Applicant would thereby obtain at least a *prima facie* exclusive right to use the mark across the nation. Such registration would cause damage and injury to Opposer.

Wherefore, Opposer prays that the application Serial Number 79/150,583 be rejected, and that the mark therein sought for the goods specified above in International Classes 8, 13, and 28 be denied and refused.

Dated: July 22, 2015

Respectfully submitted,

TANTALO & ADLER, LLP

/Michael S. Adler/

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Reference no. 93107-00125